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10/730,021	12/09/2003	Andreas Obrebski	0902-009	2756

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EXAMINER

NGUYEN, THONG Q

ART UNIT PAPER NUMBER

2872

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/730,021

Applicant(s)

OBREBSKI ET AL.

Examiner

Thong Q. Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/9/03; 6/27/05; 9/27/05 and 1/17/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-33 and 35-44 is/are pending in the application.
- 4a) Of the above claim(s) 13, 14, 17-19, 21-33 and 37-39 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 and 20 is/are allowed.
- 6) ☒ Claim(s) 16, 35, 36 and 40-42 is/are rejected.
- 7) ☐ Claim(s) 43-44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/10/04&7/8/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The present Office action is made in response to pre-amendment filed on 12/9/2003; the amendments filed on 6/27/2005 and 1/17/2006; and the communication filed on 9/27/2005 in response to the Notice of non-compliant issued by the Office on 9/20/05.

2. It is noted that in the pre0amendment of 12/9/03, applicant has made changes to the specification. There was not any change to the claims.

In the amendment of 6/27/05, applicant has canceled claims 1-12 and 34, and added a new set of claims, i.e., claims 35-44, into the application. As a result, the pending claims are claims 13-33 and 35-44.

In the communication of 9/27/05, applicant has filed a list of claims in response to the Notice of non-compliant issued by the Office on 9/20/05.

In the amendment of 1/17/06, applicant has amended the specification. There was not any change to the claims.

### ***Election/Restrictions***

3. Applicant's election with traverse of Invention II-A and species II-A-4, see the election as set forth in the amendment of 6/27/05, page 12 and the species II, see the election as set forth in the amendment of 1/17/06, page 13 are acknowledged.

4. It is noted that in the election of 1/17/06, applicant has elected species (II). Because applicant did not distinctly and specifically point out the supposed errors in the

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restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

5. Applicant's election with traverse of invention II-A and species II-A-4 in the reply filed on 6/27/05 is acknowledged. The traversal is on the ground(s) that "these two claim groups are...respectfully requested." (Amendment, page 11, the second full paragraph). This is not found persuasive because of the following reasons.

As stated by the examiner in the restriction of 4/26/05, pages 3-4, the inventions II-A and II-B are distinct from each other because the microscope with a power supply of the invention II-A does not need the specific feature related to the data transmission system, the data acquisition unit and data display system as recited in the invention II-B. Applicant has argued that both claim groups have recited common elements, and thus cannot properly be restricted. The examiner respectfully disagrees with the applicant. Applicant is respectfully invited to review the structure of the microscope as recited in the two groups. The features such as a (surgical) microscope, a stand and pivotal arms are basic components of a microscope supported by a stand. There are no new features/differences from the devices of the claim groups related to the mentioned components with respect to the prior art. The difference features are directed to the power supply and the data transmission system which each is recited in one claim group and not in the other. As such, the searches for the two mentioned claim groups are different.

Second, a microscope having a stand, a arm support for connecting a microscope to a stand wherein the microscope has a power supply is disclosed in each of the U.S. Patent Nos. 4,523,732 and 5,805,335; however, each of the Patents does not disclose any feature related to a data transmission system which is connected to the stand and the arm system.

The requirement is still deemed proper and is therefore made FINAL.

6. Applicant's election with traverse of species II-A-4 in the election of 6/27/05 is acknowledged. The traversal is on the ground(s) that the species as claimed are not mutually exclusive. See amendment of 6/27/05, page 11. This is not found persuasive because of the following reasons.

First, the Examiner respectfully disagrees with the applicant's opinion that the species are not mutually exclusive from each other. Applicant is respectfully invited to review the claims 13-20 in which the device of each claims 13-14 and 17-19 is difference from the device of each claims 15-16 and 20.

The device of claim 13 directs to the use of a power supply having electrically insulated twisted pair of wires which are attached to the arms of the stand. The device of claim 14 directs to the use of a power supply having an AC generator, an induction transmitter, and an induction receiver which are attached to the arms of the stand. The device of claims 17-19 directs to the use of a power supply having a radiation emitter disposed at a distance from the microscope and a radiation receiver disposed on the microscope. If a power supply having wires as recited in claim 13 or a power supply having generator and induction

transmitter and receiver as recited in claim 14 for transmitting electrical signals then such device cannot transmit the power or electrical signals by wireless manner as recited in the power supply of claims 17-19. The use of a power supply having wires as of claim 13 has different structure from the power supply of claim 14. An electric wire can be used to direct connect a power outlet to the microscope for the device of claim 13 does not have the same structure as the power supply having induction transmitter and receiver for the device of claim 14. Second, regarding to the applicant's arguments related to the species of claims 15-16 and 20, the Examiner agrees with the applicant's opinions and thus the restriction on the basis of species among claims 15-16 and 20 is now withdrawn. The requirement is still deemed proper and is therefore made FINAL.

7. In the light of details as set forth above, claims 15-16, 20, 35-36, and 40-44 are examined in this Office action. Claims 13-14, 17-19, 21-33 and 37-39 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions and species.

***Priority***

8. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

9. The foreign reference No. DE 43 34 069 A1 listed in the information disclosure statement filed on 5/10/2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the

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individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Applicant should note that the reference to the U.S. Patent No. 5,667,186 as provided for the mentioned foreign reference is incorrect. The U.S. Patent No. 5,667,186 is correspondent to the foreign reference DE 43 20 443 C2.

10. The reference titled thereof "Combitrans- Kontaktlose....Aerospace" and its translation as provided in the information disclosure statement filed 7/8/2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Drawings***

11. The drawings contained five sheets of figures 1-10 were received on 12/9/2003. These drawings are objected by the Examiner for the following reasons.

12. The drawings are objected to because the use of the numerical reference "19" in figure 1 is improper. It is noted that in figure 1, applicant has used the reference "19" for a light beam/path while the specification in page 15 discloses that the reference "19" is from a semireflecting mirror. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures

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appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

13. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: The reference "105" as shown in figure 6 is not mentioned in the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New



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Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

14. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

15. The disclosure is objected to because of the following informalities: The specification is objected to because it does not have a Summary of the Invention. Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)),

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and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or

REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)

(f) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(g) BRIEF SUMMARY OF THE INVENTION.

(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(i) DETAILED DESCRIPTION OF THE INVENTION.

(j) CLAIM OR CLAIMS (commencing on a separate sheet).

(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

16. The disclosure is objected to because of the following informalities: a) Page 16: lines 1-2 and 13-14, the reference "37" is used to refer to two different components, i.e., a point (as in lines 1-2) and a transmitter (as in lines 13-14); b) . Page 16: lines 26 and 28, the reference "45" is used to refer to two different components, i.e., a wireless manner (as on line 26) and a distance (as on line 28); c) Page 24: lines 25 and 28 and page 25, lines 13, 18, ..., the use of the references "103" and "133" for an antenna is improper. There are still some grammatical and idiomatic errors in the specification. Applicant should carefully proofread the specification. Appropriate correction is required.

***Claim Objections***

17. Claims 35-36 and 40-42 are objected to because of the following informalities. Appropriate correction is required.

a) Claim 35 recites that the at least one light emitter comprises at least one of a generating semiconductor device, an organic light generating device, and a light

emitting polymer device (see lines 6-9). Such a recitation is misdescriptive of the invention as taught in the specification, in particular, pages 5-7. Applicant should note that the specification discloses that the light emitter can be a generating semiconductor device or an organic light generating device or a light emitting polymer device. The specification has never disclosed that the light emitter comprises more than one kind of device as can be read from the feature recited on lines 5-7. Should the terms "at least" appeared on line 6 of the claim be deleted?

b) The remaining claims are dependent upon the objected base claim and thus inherit the deficiency thereof.

***Claim Rejections - 35 USC § 112***

18. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

19. Claims 35-36 and 40-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

a) Claim 35 is rejected under 35 USC 112, first paragraph because the disclosure does not disclose the structure of the illuminating system as recited in the feature thereof "at least one light emitter...surgical microscope" (lines 3-9).

The invention as described in the specification, pages 4-7 and 17-22 and shown in figs. 1-5 comprises a plurality of embodiments of the illuminating system. The illuminating system as described in pages 4-5 and 17-18 and shown in fig. 2 discloses a light source (63) and a light guiding system (69) for guiding light to the microscope wherein the end (73) of the light guiding system (69) acts as a light emitting element. In this embodiment, there is not any teaching related to the use of a light emitter in the form of a light generating semiconductor device or organic light generating device or light emitting polymer device.

The embodiments as described in pages 5-7, pages 17-18, and pages 20-22 and shown in figs. 1 and 3-5 discloses the use of light emitter in the form of a light generating semiconductor device or organic light generating device or light emitting polymer device. However, in these embodiments, the specification does not disclose the use of a light guiding system for supplying light to the light emitter.

b) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiency thereof.

***Claim Rejections - 35 USC § 102***

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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21. Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Hamada et al (U.S. Patent No. 5,048,941).

Hamada et al disclose a microscope system. The system as described in columns 5-6 and 12-13 and shown in figs. 2-3 and 20-21 comprises the following features: a) a microscope body (13) supporting a plurality of devices (13a-c) which are operated by electricity provided by a power supply; b) a stand (11) having a base; c) a plurality of rotating arms (12a-b) for connecting the microscope body to the stand. See columns 2-3. Regarding to the structure of the pivotal arms, in columns 12-13, Hamada et al disclose that the microscope body is attached to an end of the arm (12a) and one end of the arm (12b) is attached to the stand (11). Each of the arms is movable with respect to each other, thus the microscope body is able to move relative to the base of the stand. The stand (11) supports a plurality of connections mechanically attached to the stand so that the electrical current from the power sources (14a-c) are guided to the devices (13a-c) attached to the microscope body.

***Allowable Subject Matter***

22. Claims 15 and 20 are allowed.
23. Claims 43 and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
24. The following is a statement of reasons for the indication of allowable subject matter:

The microscope as recited in each of claim 15 and claim 43 is patentable with respect to the cited art by the limitations related to the structural relationship among the power supply and the pivotal arms of the microscope. It is noted that while the use of a microscope having a support comprises a plurality of pivotal arms and a power supply for providing light to a microscope is known to one skilled in the art as can be seen in the U.S. Patent Nos. 5,048,941; 3,776,614; 6,493,134 and 4,321,917; however, the cited art does not disclose that the power supply comprises a contact rail disposed on a first arm and a sliding contact disposed adjacent to the contact rail wherein the sliding contact is disposed on a second arm which arms are pivotally connected to each other as claimed.

The microscope as recited in each of claim 20 and claim 44 is patentable with respect to the cited art by the limitations related to the structural relationship among the power supply and the base of the stand supporting the microscope. It is noted that while the use of a microscope having a stand support a microscope and a control system having a power supply wherein the base of the stand and the control system are located on a floor of a room is known to one skilled in the art as can be seen in the U.S. Patent Nos. 5,048,941; 5,074,651 and 4,912,388; however, the cited art does not disclose that the power supply comprises an induction transmitter disposed on or in the floor of the room and the base comprises an induction receiver in communication with the induction transmitter to supply electrical current to a device located in the microscope.

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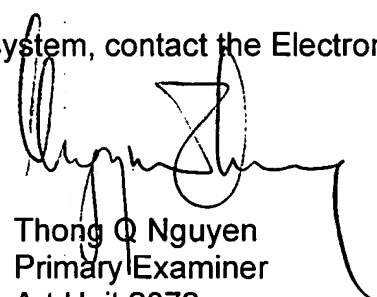
**Conclusion**

25. The prior art except the foreign reference No. DE 43 34 069 A1 and the reference titled thereof "Combitrans- Kontaktlose....Aerospace" made of record and not relied upon is considered pertinent to applicant's disclosure.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen  
Primary Examiner  
Art Unit 2872

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